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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,535	02/21/2002	Kazunori Komatsu	Q68390	3063

7590 06/13/2005  
SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER
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NEGRON, DANIEL L

ART UNIT	PAPER NUMBER
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2651

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/078,535

Applicant(s)

KOMATSU ET AL.

Examiner

Daniell L. Negrón

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The limitations "...transferring magnetic field is inclined  $0 < \alpha < 30^\circ$  or  $-30^\circ < \alpha < 0$  with respect to the slave surface" and "...transferring magnetic field is  $0 < \beta < 30^\circ$  or  $-30^\circ < \beta < 0$  with respect to the track direction on a plane parallel to the slave surface" as recited in claims 1-4 show an angle range which is inconsistent with the range disclosed in the specification of the current application. The specification discloses a range of  $\pm 30^\circ$ , which includes zero as an angle while the claims as newly amended presently exclude zero from the range. Therefore, the claims are considered to contain new matter and it is considered that the specification fails to comply with the written description requirement.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Komatsu et al U.S. Patent No. 6,570,724.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1 and 5, Komatsu et al disclose a magnetic transfer method applying a transferring magnetic field in a state that a master medium (1) for magnetically transferring in which a magnetic layer is formed in a portion corresponding to information signals on a surface of a substrate, and a magnetic recording medium which is a slave medium (4) being magnetically transferred, are in close contact with each other (column 7, lines 10-24), comprising the steps of applying a magnetic field to the slave medium in a track direction of a slave surface to initial DC magnetize the slave medium previously in the track direction (column 7, lines 55-62), bringing the master medium and the slave medium into close contact with each other and applying the transferring magnetic field in the track direction of a slave surface to execute a magnetic transfer for copying information on the surface of the master medium to the slave medium (column 7, line 63 through column 8, line 6).

Komatsu et al further disclose a magnetic transfer method wherein an application angle of the transferring magnetic field is inclined within a range of  $\pm 30^\circ$  with respect to the slave surface (column 8, lines 42-51).

Regarding claim 2, 3, 6, and 7, claim 2, 3, 6, and 7, have limitations similar to those treated in the above rejection of claim 1, and are met by the reference as discussed above.

Claims 2 and 3 however also recite the following limitations:

A magnetic transfer method wherein an application angle  $\beta$  of the transferring magnetic field is within a range of  $\pm 30^\circ$  with respect to the track direction on a plane parallel to the slave surface as disclosed by Komatsu on column 7, line 63 through column 8, line 6. The application angle of the transferring magnetic field is inherently disclosed by the reference as  $0^\circ$  since the magnetic field is being applied in the direction of track on the slave medium (i.e. in tangential direction of a circular arc).

Furthermore, since the application angle of  $\alpha$  of the transferring magnetic field as disclosed by Komatsu et al is within  $\pm 30^\circ$  and an application angle  $\beta$  is  $0^\circ$  it is considered that the sum of absolute values of an application angle  $\alpha$  and an application angle  $\beta$  is also within  $\pm 30^\circ$ .

Regarding claims 4 and 8, claims 4 and 8 have limitations similar to those treated in the above rejection of claims 1, 2, 5, and 6 and are met by the reference as discussed above.

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Regarding claims 9-12, Komatsu et al disclose a magnetic transfer method wherein a track direction is a tangential to circumferential track on the slave surface (column 7, lines 55-62).

Regarding claim 13, claim 13 has limitations similar to those treated in the above rejection of claim 4, and are met by the reference as discussed above.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniell L. Negrón whose telephone number is 571-272-7559. The examiner can normally be reached on Monday-Friday (8:30-6:00) alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DLN   
June 6, 2005

  
DAVID HUDSPETH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600